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EXAMINER	
FISCHER, ANDREW J	

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SCOTT T. HUGHES and MATTHEW W. MILNE

Appeal 2007-4275
Application 09/585,129
Technology Center 3600

Decided: June 18, 2008

Before MURRIEL E. CRAWFORD, LINDA E. HORNER, and MICHAEL W. O'NEILL, *Administrative Patent Judges*.

HORNER, *Administrative Patent Judge*.

DECISION ON APPEAL

Scott T. Hughes et al. (Appellants) seek our review under 35 U.S.C. § 134 of the final rejection of claims 1-10. We have jurisdiction under 35 U.S.C. § 6(b) (2002). We reverse.

The Appellants' claimed invention relates to distributing advertising content to a network of personal computers (Spec. 1:7-8). Claim 1, reproduced below, is representative of the subject matter on appeal.

> 1. A method of operating a content delivery system for distributing advertising content to users of personal computers, the method comprising:
>
> collecting identification data from a network of personal computers, wherein the personal computers are configured to periodically receive and store advertising content and display the advertising content while or before bootloading a user selected application environment;
>
> receiving the advertising content from an advertiser;
>
> formatting the advertising content for storage and display in the personal computer; and
>
> distributing, using the collected identification data, the formatted advertising content to the personal computers.

The Appellants seek our review of the rejection of claims 1-10 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent Appl. No. 2002/0072965 A1, published June 13, 2002 to Merriman and U.S. Patent No. 6,339,761 B1, issued January 15, 2002 to Cottingham.

The Appellants' Specification recites, "[a]s defined herein, bootloading of a user selected application environment comprises executing one or more programs to configure a personal computer to a state wherein the personal computer can execute an application program specified by the user after boot up" (Spec. 4:31 – 5:2). In view of the definition provided in

Appellants' Specification, we understand the claims to require that the advertising content is formatted and stored on personal computers such that the content is displayed either during or before the computers execute boot up programs, such as booting up of an operating system, that place the computers in a state such that the computers can execute application programs.

Both the Examiner and the Appellants agree that Merriman does not disclose personal computers that receive and store advertising content and display the advertising content while or before bootloading a user selected application environment (Ans. 3-4). The Examiner found that Cottingham discloses personal computers configured "to periodically receive and store advertising content and display the advertising content while or before bootloading a user selected application environment" (Ans. 4). We disagree.

Cottingham discloses a system in which an Internet service provider can use a computer program to cause advertising content to be displayed prior to display of digital content, such as a web-page, video, streaming video, audio, streaming audio, graphics, etc. (Cottingham, col. 3, ll. 35-43 and col. 7, ll. 50-58). While Cottingham discloses display of advertising content prior to display of other digital content, it does not disclose display of advertising content prior to or while the computer bootloads programs, such as an operating system, that place the computer in a state where the computer can then execute an application program.

In rejecting claims under 35 U.S.C. § 103(a), the examiner bears the initial burden of establishing a prima facie case of obviousness. *In re*

Oetiker, 977 F.2d 1443, 1445 (Fed. Cir. 1992); *see also In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984). Because we disagree with the Examiner's finding as to the scope and content of Cottingham, we determine that the Examiner has failed to set forth a prima facie case of obviousness, and we will not sustain the rejection of claims 1-10 as unpatentable over Merriman and Cottingham.

CONCLUSIONS

We conclude that the Appellants have shown the Examiner erred in rejecting claims 1-10 under 35 U.S.C. § 103(a) as unpatentable over Merriman and Cottingham.

DECISION

The decision of the Examiner to reject claims 1-10 is reversed.

REVERSED

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